

Remarks/Arguments

Claims 1-20 are pending in the present application. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 103, Asserted Obviousness of Claims 1-9, 12, and 14-20

The examiner rejected claims 1-9, 12, and 14-20 under 35 U.S.C. § 103 as being obvious over *Derocher et al.*, Mouse Recharging Module, U.S. Patent 6,476,795 (Nov. 5, 2002) (hereinafter “*Derocher*”) in view of *Koripella et al.*, Direct Methanol Fuel Cell System and Method of Fabrication, U.S. Patent 6,387,559 (May 14, 2002) (hereinafter “*Koripella*”). This rejection is respectfully traversed.

The examiner states that:

2. Claims 1-9, 12, and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Derocher et al.* (US 6,476,795) in view of *Koripella et al.* (US 6,387,559).

With respect to claim 1, *Derocher* discloses, a wireless optical navigation device (fig. 2) comprising: an optical position tracking system (col. 3, lines 40-43); a transmitter electrically coupled to said optical position tracking system (52 in fig. 2).

Derocher does not expressly disclose a micro fuel cell electrically coupled to said transmitter and said optical position tracking system, said micro fuel cell capable of providing electrical power for said optical position tracking system and said transmitter.

Koripella discloses a micro fuel cell (fig. 3) electrically capable of providing electrical power (col. 6, lines 1-4).

Derocher and *Koripella* are analogous art because they are directed at a similar problem solving area, namely powering handheld electronic devices (*Koripella*, 60 in fig. 3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use the portable device fuel cell taught by *Koripella* on the wireless optical mouse disclosed by *Derocher*.

The motivation for doing so would have been to lengthen the battery life of the device.

Therefore it would have been obvious to combine *Koripella* with *Derocher* for the benefit of longer battery life to obtain the invention as specified in claim 1.

Office Action of September 1, 2005, pp. 2-3.

I.A. The Proposed Combination Does Not Teach all of the Features of Claim 1

Regarding claim 1, the examiner has failed to state a *prima facie* obviousness rejection because the proposed combination does not teach all of the features of claim 1. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). In the case at hand, not all of the features of the claimed invention have been considered and the teachings of the references themselves do not suggest the claimed subject matter to a person of ordinary skill in the art.

Claim 1 is as follows:

1. (Original) A wireless optical navigation device comprising:
an optical position tracking system;
a transmitter electrically coupled to said optical position tracking system; and
a micro fuel cell electrically coupled to said transmitter and said optical position tracking system, said micro fuel cell capable of providing electrical power for said optical position tracking system and said transmitter.

Claim 1 contains the feature that a micro fuel cell is electrically coupled to the transmitter and to the optical position tracking system. The examiner admits and Applicants agree that *Derocher* does not teach or suggest this feature. In addition, *Koripella* does not teach or suggest this feature. While *Koripella* does show a fuel cell system, *Koripella* does not teach or suggest a fuel cell system electrically coupled to a transmitter and to an optical position tracking system. The examiner fails to assert otherwise. For these reasons, the proposed combination of *Koripella* and *Derocher* does not teach all of the features of claim 1 when the references are considered as a whole. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.B. The Proposed Combination Changes the Principle of Operation of the Primary Reference

Further regarding claim 1, the examiner has failed to state a *prima facie* obviousness rejection because the proposed combination changes the principle of operation of the primary reference. In combining references to show the claimed feature, the proposed modification cannot change the principle of operation of a reference. See *In re Ratti*, 270 F.2d 810, 123

(CCPA 1959) and MPEP 2143.01. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Id.

In the case at hand, the proposed combination changes the principle of operation of the primary reference. The primary reference, *Derocher*, is concerned with a laptop system including a portable battery recharger for a wireless mouse. *Derocher* describes in great detail the principle and workings of the portable battery recharger. Specifically, *Derocher* provides that:

FIG. 5 is a perspective illustration of a portable computing system having a portable computer 10 with an accessory bay 26 in a base 28. A display 14 is attached to the base 28, preferably with a rotating hinge. The display allows a user to view information from the portable computer 10. The user can highlight or select information on the screen using a cursor 20. A wireless mouse 50 using wireless transceiver 52 to a wireless transceiver 16 in the portable computer 10 controls the cursor 20. A rechargeable battery preferably powers the wireless mouse 50. When the mouse battery need to be recharged, the user fits the wireless mouse 50 into a mouse bay 40 in a module 30. The module 30 makes contact with a battery charger within the portable computer 10 using module connector 32. Optionally, the module 30 has a reserve battery 36 and a reserve charger 34 which are used to recharge the battery in the wireless mouse 50 even if the module 30 is not fitted within portable computer 10. The reserve battery 36 is itself recharged when the module 30 is placed in accessory bay 26 of the portable computer 10.

Derocher, col. 4, ll. 34-52.

As shown above, *Derocher* only teaches that the wireless mouse use a conventional rechargeable battery that is recharged in a conventional manner. *Derocher* does not teach or suggest any other mechanism for providing power to the wireless mouse; indeed, to provide another system for providing power to the wireless mouse would defeat the entire purpose of *Derocher's* recharging device. Providing power to the wireless mouse via any principle other than that described in *Derocher* would mean modifying, altering or replacing the principle of operation of *Derocher's* system. In this case, the examiner's proposed combination changes the principle of operation of *Derocher's* system because a fuel cell would be used with the *Derocher* mouse, but a fuel cell is not rechargeable in the manner taught by *Derocher*. In other words, the examiner's proposed combination changes the principle of how the batteries in *Derocher's* mouse are recharged. As shown above, *In re Ratti* provides that changing the principle of operation of a device renders a claim non-obvious in view of the proposed combination. Therefore, claim 1 is non-obvious in view of the proposed combination and the

examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.C. The Examiner Has Not Stated a Proper Teaching, Suggestion or Motivation to Combine the References

In addition, the examiner has failed to state a *prima facie* obviousness rejection against claim 1 because the examiner has not stated a proper teaching, suggestion, or motivation to combine the references. Instead, the examiner has only stated a proposed advantage to combining the references. However, an advantage is not necessarily a teaching, suggestion, or motivation. To constitute a proper teaching, suggestion, or motivation, the examiner must establish that one of ordinary skill would both recognize the advantage and have a reason to implement the advantage. For example, a first reference may disclose the use of lasers to achieve nuclear fusion. A second reference may disclose that ultra-high power lasers deliver more energy. One of ordinary skill may recognize that an ultra-high power laser would be more useful to achieve nuclear fusion, though one of ordinary skill would be motivated to avoid combining the references because of the extreme expense of ultra-high power lasers. In this example, one of ordinary skill is motivated to avoid implementing the combination, even if he or she recognized the advantage, and so no teaching, suggestion, or motivation exists to combine the references.

In the case at hand, the examiner has not provided a sufficient reason why one of ordinary skill would recognize the proposed advantage or have a reason to implement it. The examiner states that “the motivation for doing so would have been to lengthen the battery life of the device.” However, the proposed motivation does not actually exist because *Derocher’s* rechargeable battery system vitiates any putative need to extend the battery life of *Derocher’s* mouse. For these reasons, the examiner’s statement fails to provide a proper teaching, suggestion, or motivation to combine the references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

In addition, the references themselves do not suggest the proposed advantage. In the present case, neither *Derocher* nor *Koripella* teach incorporating a fuel cell into a wireless mouse. Accordingly, the examiner has not actually stated a teaching or suggestion based on the references to combine the references. Similarly, the examiner has not asserted a teaching, suggestion, or motivation that can be found in some other form of prior art. Instead, the examiner has only put forth a hypothetical advantage of combining the references based on the examiner’s opinion rather than on a pre-existing teaching, suggestion, or motivation. Thus, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.D. No Teaching, Suggestion, or Motivation Exists to Combine the References

In addition, a *prima facie* obviousness rejection against claim 1 has not been made because no proper teaching or suggestion to combine the references exists. A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). A proper *prima facie* case of obviousness cannot be established by combining the teachings of the prior art absent some teaching, incentive, or suggestion supporting the combination. *In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995); *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d 1566, 1568 (Fed. Cir. 1990). No such teaching or suggestion is present in the cited references and the examiner has not pointed out any teaching or suggestion that is based on the prior art.

In this case, *Derocher* has no need for placing a fuel cell inside the wireless mouse and *Koripella* provides no reason to add a fuel cell to the wireless mouse of *Derocher*. *Derocher* teaches a system for recharging the batteries of a wireless mouse. The entire purpose of *Derocher*'s system is to recharge the batteries of the wireless mouse. *Derocher* has no need for adding a fuel cell to the wireless mouse of *Derocher* because *Derocher* does not need to extend the battery life of the wireless mouse. Accordingly, *Derocher* does not show a shortcoming or a need for a fuel cell that would suggest or motivate one of ordinary skill to look to *Koripella*. Because no need for the proposed combination exists, and because no pre-existing teaching, suggestion, or motivation to combine the references has been pointed out, no teaching, suggestion, or motivation exists to combine the references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.E. No Teaching or Suggestion Exists To Combine the References Because Each Reference Represents a Complete Solution to the Problem That Each Solves

Both *Derocher* and *Koripella* represent complete solutions to the problems each solves. *Derocher* shows a device for recharging batteries in a wireless mouse. *Derocher* has no need to address the problem recharging mouse batteries or extending the lifetime of mouse batteries because *Derocher* provides a mechanism to recharge the batteries quickly and easily. On the other hand, *Koripella* shows a miniaturized fuel cell and *Koripella* represents a complete solution for fashioning such a device. Because each reference provides a complete solution to the problem that each reference represents and neither reference

indicates that a fuel cell should be included in a wireless mouse as claimed, one of ordinary skill would have no reason to combine or otherwise modify the references. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.F. The Examiner Used Impermissible Hindsight When Fashioning the Rejection

In addition, the examiner's has failed to state a *prima facie* obviousness rejection against claim 1 because the examiner used impermissible hindsight when fashioning the rejection. Personal opinion cannot be substituted for what the prior art teaches because a *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). In this case, the examiner believes that, "the motivation for doing so would have been to lengthen the battery life of the device." However, *Derocher* has no need for to extend battery life of a wireless mouse, as evidenced by the fact that the *Derocher*'s entire invention is directed to keeping the batteries in the wireless mouse recharged, or to easily recharging the batteries in the wireless mouse. *Koripella* fails to provide a reason to include a fuel cell in a wireless device in the manner claimed. Given that *Derocher* has no need for a fuel cell, and given that *Koripella* suggests no reason to place a fuel cell in a wireless mouse, one of ordinary skill would have no reason to combine or otherwise modify the references.

Based on the plain disclosures in the references, the only suggestion to modify the references is found in Applicants' specification. Hence, the examiner must have used Applicants' specification to find a teaching, suggestion, or motivation to combine the references. Doing so is impermissible hindsight and fails to comport with the standards of *Graham v. John Deere Co.*, 383 U.S. 1 (1966), which requires a proper teaching, suggestion, or motivation to combine or modify references to achieve a proper obviousness rejection. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.G. *Derocher* and *Koripella* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 1 because the references are directed towards solving different problems. "It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a

solution to the problem facing the inventor.” *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Derocher* is directed to solving the problem of recharging batteries in a wireless mouse. For example, *Derocher* provides that:

The invention relates to a wireless mouse for a portable computer, more specifically, it relates to charging a battery within the mouse by using a module for an accessory port of the portable computer.

...

The invention provides a simple, compact, and convenient method of providing a mouse type device for a portable computer. By preferably combining an optical sensing mouse in a retractable package with a wireless link, desktop mouse functionality is achieved. However, to power the optical sensing circuits and wireless link, the mouse has a battery power source. To prevent the user from having to carry a supply of replacement batteries, the mouse battery is preferably rechargeable. One aspect of the invention is to provide an accessory module for an accessory bay in the portable computer. The accessory module has positioning walls that allow the mouse to be docked and connected to a recharging circuit. Another aspect of the invention is to allow the mouse to be recharged whether or not the accessory module is inserted into the accessory bay of the portable computer. Further aspects will become apparent in the detailed description of embodiments of the invention.

Derocher, col. 1, ll. 5-8 and col. 2, ll. 44-60.

On the other hand, *Koripella* is directed to the problem of miniaturizing fuel cells. For example, *Koripella* provides as follows:

During operation of a direct methanol fuel cell, a dilute aqueous methanol (usually 3-46 methanol) solution is used as the fuel on the anode side. If the methanol concentration is too high, then there is a methanol crossover problem that will reduce the efficiency of the fuel cell. If the methanol concentration is too low then there will not be enough fuel on the anode side for the fuel cell reaction. Current DMFC designs are for larger stacks with forced airflow. The smaller air breathing DMFC designs are difficult to accomplish because of the complexity in miniaturizing the system for portable applications. For portable applications carrying the fuel in the form of a very dilute methanol mixture would require carrying a large quantity of fuel which is not practical for the design of a miniature power source for portable applications. Miniaturizing the DMFC system requires carrying methanol and water separately and mixing them in-situ for the fuel cell reaction. Recirculation of the water fuel mixture after the fuel cell reaction and recycling of the water generated in the fuel cell reaction,

in addition to the water diffused across the membrane is also required for miniaturizing the system.

Accordingly, it is a purpose of the present invention to provide for a direct methanol fuel cell system design in which at least one direct methanol fuel cell is integrated into a miniaturized system.

Koripella, col. 1, l. 51 through col. 2, l. 9.

Thus, the references address completely distinct problems that are utterly unrelated to each other. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

Nevertheless, the examiner believes that:

Derocher and *Koripella* are analogous art because they are directed at a similar problem solving area, namely powering handheld electronic devices (*Koripella*, 60 in fig. 3).

Office Action of September 1, 2005, p. 2.

The examiner's statement does not adequately address the fact that *Derocher* and *Koripella* address different problems. The examiner's statement refers to an overly-broad perspective of the references when considered as a whole. The examiner essentially states that because the two references address powering hand-held electronic devices, that the references are analogous. However, this statement is too broad to rebut the fact that the references address entirely different problems. Therefore, combining the references to achieve the claimed invention would not be obvious.

For example, as shown above and below, when the technical details of the references are considered, the logical conclusion to draw is that one of ordinary skill would not combine the references because combining the references would defeat the purpose of *Derocher*'s system. The reason for this fact is, in part, derived from the fact that the references address different problems. The examiner has not overcome the specific deficiencies in *Derocher* and *Koripella* and has not overcome any of the specific facts pointed out by Applicants that show that one of ordinary skill would not combine the references when the references are considered as a whole. For this reason, and for the reasons already given, the examiner has failed to state a *prima facie* obviousness rejection against claim 1.

I.H. Summary of Why the Examiner Has Failed to State a *Prima facie* Obviousness Rejection Against Claim 1.

In general, the examiner appears to proceed from the false assumption that just because individual elements of a claimed invention can be found in two or more references, that combining the references would automatically render the claimed invention obvious to one of ordinary skill. In fact, that vast bulk of patentable inventions are derived from combinations of elements that can be found the prior art.

In the case at hand, the examiner has failed to state a *prima facie* obviousness rejection for the following reasons: The proposed combination does not teach all of the features of claim 1; combining the references would change the principle of operation of *Derocher*'s device; the examiner has not stated a proper teaching, suggestion or motivation to combine the references; no teaching, suggestion, or motivation exists to combine the references; the examiner used impermissible hindsight when fashioning the rejection; and *Derocher* and *Koripella* would not be combined by one of ordinary skill in the art because they address different problems. Therefore, Applicants request that the rejections against claim 1 be withdrawn and that claim 1 be allowed.

I.I. Claims 2-9, 12, and 14-20

Independent claim 14 includes similar features to those presented in claim 1. Hence, for the reasons presented above vis-à-vis claim 1, the examiner has failed to state a *prima facie* obviousness rejection against claim 14. In addition, claims 2-9, 12, and 15-20 all depend from claims 1 or claim 14, accordingly. Because these claims depend from claims 1 or 14, the examiner has failed to state a *prima facie* obviousness rejection against these claims at least for the reasons presented above vis-à-vis claim 1. Accordingly, Applicants request that the rejections against these claims be withdrawn and that these claims be allowed.

II. 35 U.S.C. § 103, Asserted Obviousness of Claim 10

The examiner rejects claim 10 under 35 U.S.C. § 103 as obvious over *Derocher* in view of *Koripella* in view of *Hirsch et al.*, Fuel Delivery Cartridge and Anodic Fuel Receptor for a Fuel Cell, U.S. Patent 6,924,055 (August 2, 2005) (hereinafter "*Hirsch*"). This rejection is respectfully traversed.

II.A. Dependency of Claim 10 on Claim 1

The examiner has failed to state a *prima facie* obviousness rejection against claim 10 at least because claim 10 depends on claim 1. The examiner has failed to state a *prima facie* obviousness rejection against claim 1 for the reasons provided above. Accordingly, Applicants request that the rejection against claim 10 be withdrawn and that claim 10 be allowed.

II.B. *Derocher*, *Koripella* and *Hirsch* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 10 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Derocher* is directed to solving the problem of recharging batteries in a wireless mouse, as shown above. In contrast, *Koripella* is directed to the problem of miniaturizing fuel cells, as shown above. In further contrast, *Hirsch* is directed to the problem of delivery fuel to the active anode chamber of a fuel cell as the fuel is consumed, as shown below:

There remains a need, therefore, for a fuel delivery cartridge, direct methanol fuel cell, and a direct methanol fuel cell system that provides optimal fuel delivery properties by which fuel can be delivered to the active anode chamber as it is consumed, thereby minimizing the amount of additional fuel that is introduced, and limiting the amount of fuel that crosses over the membrane. There remains a further need to provide a cathode chamber in the fuel cell that resists water build up, while allowing oxygen to come into contact with the cathode face of the membrane.

It is thus an object of the invention to provide a fuel cell and fuel cartridge that provides fuel to the anode as it is consumed and reduces the risk of cathode flooding, while keeping the cost and complexity of the fuel cell to a minimum.

Hirsch, col. 3, ll. 37-51.

The three references address completely distinct problems that are unrelated to each other. Because the references address completely distinct problems, one of ordinary skill

would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 10.

Nevertheless, the examiner believes that:

Derocher, *Koripella*, and *Hirsch* are all analogous art because they are directed at a similar problem solving area, namely powering portable devices.

Office Action of September 1, 2005, p. 4.

The examiner's statement does not adequately address the fact that *Derocher*, *Koripella*, and *Hirsch* address different problems. The examiner's statement refers to an overly-broad perspective of the references when considered as a whole. The examiner essentially states that because the two references address powering "portable" devices, that the references are analogous. However, this statement is too broad to rebut the fact that the references address entirely different problems. Therefore, combining the references to achieve the claimed invention would not be obvious.

III. 35 U.S.C. § 103, Asserted Obviousness of Claim 11

The examiner rejects claim 11 under 35 U.S.C. § 103 as obvious over *Derocher* in view of *Koripella* in view of *Peng*, Wireless Mouse Capable of Generating and Accumulating Electrical Energy, U.S. Patent 6,686,903 (February 3, 2004) (hereinafter "*Peng*"). This rejection is respectfully traversed.

III.A. Dependency of Claim 11 on Claim 1

The examiner has failed to state a *prima facie* obviousness rejection against claim 11 at least because claim 11 depends on claim 1. The examiner has failed to state a *prima facie* obviousness rejection against claim 1 for the reasons provided above. Accordingly, Applicants request that the rejection against claim 11 be withdrawn and that claim 11 be allowed.

III.B. *Derocher*, *Koripella* and *Peng* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 11 because the references are directed towards solving different problems. It is

necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Derocher* is directed to solving the problem of recharging batteries in a wireless mouse, as shown above. In contrast, *Koripella* is directed to the problem of miniaturizing fuel cells, as shown above. In further contrast, *Peng* is directed to the problem of frequently replacing batteries in a wireless mouse, as shown below:

The development of the personal computer has been very rapid. The prior large-size computers have been modified into a desk-top or even smaller size personal computers (PC). Size minimization becomes one of the reasons causing the popularity of the PC. A PC is usually accompanied by peripherals, such as a mouse and a keyboard. However, the wires of the computer peripherals cause the user great inconvenience. Since the wires connected to the computer may tangle with each other or other objects, the application of a mouse is limited. To meet the requirement of the users, a wireless mouse has therefore been proposed. Conventionally, a battery has been essential for the operation of a wireless mouse. However, frequent replacement of the battery still causes the user great inconvenience and extra expense. Moreover, it wastes additional natural resources and produces more wastes like the used battery.

Peng, col. 1, ll. 14-30.

The three references address completely distinct problems that are unrelated to each other. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 11.

Nevertheless, the examiner believes that:

Derocher, *Koripella*, and *Peng* are all analogous art because they are directed at a similar problem solving area, namely powering handheld devices.

Office Action of September 1, 2005, p. 5.

The examiner's statement does not adequately address the fact that *Derocher*, *Koripella*, and *Peng* address different problems. The examiner's statement refers to an overly-broad perspective of the references when considered as a whole. The examiner

essentially states that because the two references address powering “handheld” devices, that the references are analogous. However, this statement is too broad to rebut the fact that the references address entirely different problems. Therefore, combining the references to achieve the claimed invention would not be obvious.

IV. 35 U.S.C. § 103, Asserted Obviousness of Claim 13

The examiner rejects claim 13 under 35 U.S.C. § 103 as obvious over *Derocher* in view of *Koripella* in view of *Freathy* et al., Wireless Tag and Monitoring Center System for Tracking the Activities of Individuals, U.S. Patent 6,774,797 (August 10, 2004) (hereinafter “*Freathy*”). This rejection is respectfully traversed.

IV.A. Dependency of Claim 13 on Claim 1

The examiner has failed to state a *prima facie* obviousness rejection against claim 13 at least because claim 13 depends on claim 1. The examiner has failed to state a *prima facie* obviousness rejection against claim 1 for the reasons provided above. Accordingly, Applicants request that the rejection against claim 13 be withdrawn and that claim 13 be allowed.

IV.B. *Derocher*, *Koripella* and *Freathy* Would Not Be Combined By One of Ordinary Skill in the Art Because They Address Different Problems

One of ordinary skill would not combine the references to achieve the invention of claim 13 because the references are directed towards solving different problems. It is necessary to consider the reality of the circumstances--in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992); *In re Wood*, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (CCPA 1979). The cited references do not address the same problems.

In the case at hand, *Derocher* is directed to solving the problem of recharging batteries in a wireless mouse, as shown above. In contrast, *Koripella* is directed to the problem of miniaturizing fuel cells, as shown above. In further contrast, *Freathy* is directed to the problem of tracking criminal offenders who are under house arrest, as shown below:

Electronic monitoring of individuals such as offenders, has primarily relied upon electronic monitoring at a fixed located such as the offenders home or place of employment. These systems relied upon a land line telephone link and are commonly known as house arrest

systems. These systems utilized a body worn transmitter which could not be removed by the offender and a stationary receiver located at the monitoring location. The body worn portion of the device transmits a signal a short distance to the receiver located at the monitoring location. The receiver communicates with a central monitoring service over standard telephone lines. The tracking system of this type is limited in that it can only provide an indication of the presence or absence of the offender at the monitored location at a given time. This type of system cannot offer location information if the offender leaves the monitored location.

Freathy, col. 1, ll. 11-26.

The three references address completely distinct problems that are unrelated to each other. Because the references address completely distinct problems, one of ordinary skill would have no reason to combine or otherwise modify the references to achieve the claimed invention. Thus, one of ordinary skill in the art would not combine these references as proposed by the examiner. Accordingly, the examiner has failed to state a *prima facie* obviousness rejection against claim 13.

Nevertheless, the examiner believes that:

Derocher, *Koripella*, and *Freathy* are all analogous art because they are directed at a similar problem solving area, namely powering compact devices.

Office Action of September 1, 2005, p. 6.

The examiner's statement does not adequately address the fact that *Derocher*, *Koripella*, and *Freathy* address different problems. The examiner's statement refers to an overly-broad perspective of the references when considered as a whole. The examiner essentially states that because the two references address powering "compact" devices, that the references are analogous. However, this statement is too broad to rebut the fact that the references address entirely different problems. Therefore, combining the references to achieve the claimed invention would not be obvious.

V. Summary

All of the rejections rely on the combination of *Derocher* and *Koripella*. However, as shown vis-à-vis the rejection against claim 1, one of ordinary skill would not combine *Derocher* and *Koripella* to achieve the claimed inventions because *Derocher* has no need of a fuel cell, such as that shown in *Koripella*. The examiner has not shown otherwise. Thus, the examiner has failed to state a *prima facie* obviousness rejection against any of the claims.

In addition, each of the cited references addresses very different problems. For example, *Derocher* addresses the problem of recharging mouse batteries and *Koripella* addresses problems associated with building a fuel cell. In further contrast, *Freathy* is directed to the problem of building a device for tracking criminal offenders under house arrest. The widely disparate problems addressed by each reference and the different types of devices taught by each reference show that the examiner merely picked and chose elements from the prior art and combined them using Applicants' disclosure as a template. Thus, the examiner used impermissible hindsight when fashioning the obviousness rejections. Accordingly, the examiner failed to state a *prima facie* obviousness rejection against any of the claims. Therefore, the rejection against claims 1-20 under 35 U.S.C. § 103 has been overcome.

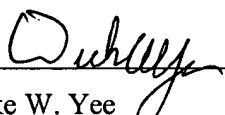
VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 12/01/05

Respectfully submitted,



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